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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,601	09/05/2003	Mario Festag	M&N-IT-566	7972
22913	7590	09/12/2006	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			CARPIO, IVAN HERNAN	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

A

**Office Action Summary**

Application No.

10/656,601

Applicant(s)

FESTAG ET AL.

Examiner

Ivan H. Carpio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22 and 25-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-35 is/are allowed.
- 6) ☒ Claim(s) 22, 25-32 and 36-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 –22 and 25-42 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22,25-32,37 and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumiya (US Patent 6480390) in view of Uwabo (US Patent 6134082).

With respect to claim 22 Matsumiya teaches a plug-in electronic module for plugging into a holding structure having a coupling partner with an electrical contact, the electronic module comprising: a housing (Fig. 13a, element 76); an electronic component (Fig. 13a, note it is understood that components inside element 76 are connected to contacts 22, column 1 paragraph 3) configured in said housing; at least one external electrical contact (Fig. 13a, element 22) connected to said electronic component, said external contact being fixed relative to said housing, said external electrical contact configured for contacting the electrical contact on the coupling partner

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(column 11, lines 7-9) during a plug-in operation in which the electronic module is plugged into the holding structure; and a mechanical protective device (Fig. 13a, elements 78 and 76) for protecting said electrical contact from mechanical contact when the electronic module is not plugged into the holding structure, said protective device exposing said electrical contact when the electronic module is plugged into the holding structure such that said electrical contact comes into contact with the electrical contact on the coupling partner; said protective device includes a moving protective element being displaceable relative to said housing and being configured for moving between a first position and a second position (Fig. 13a, and 13b); said electrical contact is protected when said moving protective element is in said first position; said electrical contact is exposed when said moving protective element is in said second position; and said moving protective element moves from said first position to said second position when the electronic module is plugged into the holding structure. In this embodiment Matsumiya does not teach a spring element for holding said moving protective element in said first position in an unplugged state, said spring element allowing said protective element to move into said second position counter to a spring force during said plug-in operation. Uwabo teaches a spring element (Fig. 4, element 21) for holding a moving protective element in said first position in an unplugged state, said spring element allowing said protective element to move into said second position counter to a spring force during said plug-in operation. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the spring element 21 of Uwabo with the protective moving element 78 of Fig.13a of Matsumiya for the

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purpose of protecting the electrical contacts 22 at all times except when contacting the coupling partner.

With respect to claim 25 and with all the limitations of claim 22, modified Matsumiya teaches that the protective element is a flat protective tongue that is displaceable longitudinally relative to said (Fig. 13a, element 78) housing.

With respect to claim 26 and with all the limitations of claim 25, modified Matsumiya teaches that part of said protective tongue having a circulatory concave profile for mechanically guiding said spring element on said protective tongue (Fig. 13b).

With respect to claim 27 and with all the limitations of claim 22 modified Matsumiya teaches one spring element for holding said moving protective element in said first position in an unplugged state; said spring element allowing said protective element to move into said second position counter to a spring force during said plug-in operation.

With respect to claim 28 and with all the limitations of claim 27, modified Matsumiya teaches that said spring element is formed integral with said housing (Uwabo fig. 4, element 21).

With respect to claim 29 and with all the limitations of claim 27, modified Matsumiya teaches that the spring element is a separate part that is mounted on said housing or inserted into said housing (Uwabo Fig. 4, element 21)).

With respect to claim 30 and with all the limitations of claim 22, Matsumiya teaches that moving protective element includes a stop (Fig. 13a, element 78 the front

half) element for mechanically contacting the coupling partner during said plug-in operation such that said moving protective element is moved into said second position and said electrical contact is exposed.

With respect to claim 31 and with all the limitations of said moving protective element includes an end with an angled-away part (fig. 13a, element 78 the front peripheral surface) forming said stop element; and said angled away part is a first part of said moving protective element touched by the holding structure during said plug-in operation.

With respect to claim 32 and with all the limitations of claim 22, Matsumiya teaches that said moving protective element is moveable into itself (Fig. 13a and 13b note that the 76 moves into element 78) and has an end connected firmly to said housing (Fig. 13b, element 78 the small bottom hook like protrusion that is connected to the bottom of the housing).

With respect to claim 37 and with all the limitations of claim 22, Matsumiya teaches all of the limitations in this embodiment, fig. 13a,b, except does not teach specifically that the protective element is made of insulating material. In another embodiment Fig. 14a,b Matsumiya teaches that the protective element 82 is made of an insulating material (Column 11, lines 62-65). It would have been obvious to make the moving protective element 78, out of an insulating material, as taught by fig. 14a,b element 82, for the purpose of elimination possible static discharge that could affect the internal components. Further more it has been found to be within the general skill of a

worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 39 and with all the limitations of claim 22, Matsumiya teaches that said moving protective element is spaced apart from said contact in a first position (Fig.13a, element 78).

With respect to claim 44 and with all the limitations of claim 22, modified Matsumiya teaches that the moving protective element is configured to engage a portion of the holding structure, wherein an insertion force is applied to the moving protective element by the holding structure when the electric module is plugged in to the holding structure thereby moving the moving protective element into the second position (note Uwabo's moving protective element works in this way).

With respect to claim 45 and with all the limitations of claim 22, modified Matsumiya teaches that a portion of the moving protective element is configured to be received within the housing when the electronic module is plugged into the holding structure thereby exposing the electronic contact (Note Uwabo's moving protective element works in this way).

Claims 36,38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumiya (US Patent 6480390) in view of Fischer (US Patent 6857791).

With respect to claim 36 and 38, Matsumiya teaches all of the limitations except that he does not disclose expressly that said protective element is made of an

electrically conductive material or that it is made of material that absorbs electromagnetic waves. Fischer teaches a module having a protective element made of an electrically conductive material (page 8, col.2, lines 9-10) or of a material that absorbs electro magnetic waves (page 8, col.2, lines 14-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to make the moving protective element from an electrically conductive material or of a material that absorbs electromagnetic waves because the use of these materials reduces interference radiation (Fischer column 2, lines 42-47). Further more it has been found to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 40 and with all the limitations of claim 22, Matsumiya teaches all of the limitations except that the electronic component includes an optoelectronic transmitter, an optoelectronic receiver, or an optoelectronic transceiver. Fischer teaches a module including and optoelectronic transceiver, and optoelectronic receiver, or an optoelectronic transceiver (page 8, column 1, lines 29-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to have the electronic component to include an optoelectronic transmitter, an optoelectronic receiver, or an optoelectronic transceiver for the purpose of having the electronic module interact wirelessly with other electronic devices such as test devices.



With respect to method claims 41-43, one skilled in the art would necessarily perform the recited method steps in connecting the electronic module to a holding structure.

***Allowable Subject Matter***

Claims 33-35 are allowed. The following is an examiner's statement of reasons for allowance: The primary reason for indicating allowable subject matter is that there is simply no suggestion in the prior art that describes the moving protective element can be folded during said plug-in operation to expose said electrical contact along with all the limitations of the claimed combination.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ivan H. Carpio whose telephone number is 571-272-8396. The examiner can normally be reached on M-R 6:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kammie Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IC

  
ISHWAR PATEL  
PRIMARY EXAMINER